

REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the November 7, 2003 Office Action, wherein claims 1-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jecha et al. in view of Sieber, and the cited publication concerning "inline plug-ins". In response, Applicant has cancelled claims 1-12 and 14 and amended independent claim 13 and 20. For the reasons set forth below, Applicant believes that these amendments place the application in condition for allowance. Reconsideration and reexamination of the application, as amended, is respectfully requested.

TIME EXTENSION

Applicant submits herewith a Three-month Time Extension Request, with appropriate fee.

CLAIM REJECTIONS

The Jecha reference is directed to a computerized process for creating a document and uploading a document to a server for translation into a suitable pre-press format. As discussed in column 4, lines 35-40, Jecha is not limited to any particular document but instead is only limited, as disclosed in column 6, to a given work area. The authoring program of Jecha allows the user to create an electronic document, display the electronic document and allow the user to select and edit elements of the electronic document before transferring it to the server for printing. Essentially, Jecha teaches a process of preparing a document for a pre-press format utilizing a computer system as opposed to the traditional method of utilizing a graphic artist and manually completing these steps to prepare the document for a pre-press format.

In contrast, the present invention resides in a process for improving print quality of a document created utilizing Internet-type network applications by accessing a web-site server having a selection of pre-prepared and unalterable document layouts. A customized document

request is created utilizing a plug-in component on the local computer. The customized document request includes selecting the document type and document content (which is pre-prepared and unalterable) and also comprises selecting at least one of a graphics image, document resolution and image and text orientation, as recited in amended independent claims 13 and 20. Once the document request is created, the web browser interfaces with the server and the one or more document layouts selected are retrieved and the document request is fulfilled and sent to the local computer. (See independent claims 13 and 20).

Jecha does not involve the selection of pre-prepared and unalterable document layouts. Rather than selecting graphics images, document resolution, image and text orientation, and either selecting pre-prepared text or creating text for the pre-prepared and unalterable layouts, Jecha involves the creation of an entire document by the end user which is then formatted according to pre-press formatting parameters.

The Office Action admits as much. Thus, Sieber is combined with Jecha and the plug-in reference in rejecting these claims. Sieber is directed to a system for automatically generating the page layout of a printed document from a user-defined text and graphic elements. Text and graphic elements in a page layout are automatically arranged in accordance with a plurality of constraints of a selected page specification. Essentially, Sieber teaches that a user selects a piece of artwork from a database of artwork and selects a message text from a database of stored messages texts, and then the system automatically generates a greeting card layout, or other layout, in accordance with the artwork specification through selective manipulation of the text and artwork.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

In Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), it was held that "while the references need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be "clear and particular." In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. [Emphasis added]. In the instant office action, the showing of combinability is far from "clear and particular."

"For a proper obviousness combination, the prior art reference must provide a suggestion or motivation to make such a combination." Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 168, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) citing Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 934 15 USPQ2d 1321, 1323 (Fed. Cir. 1990).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.*

The mere fact that the reference can be combined or modified, does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 citing, in re Mills, 16 USPQ 2d 1430 (Fed. Cir. 1990). As discussed in the MPEP, using the Applicant's disclosure raises to impermissible hindsight reconstruction.

Jecha is not limited whatsoever to layouts or templates. Instead, the end user is free to include whatever images and graphics he or she desires,

and then the server translates this document into a suitable pre-press format. In contrast, Sieber teaches the automated selection of a template based upon the graphics and text that the user has selected. That is, e.g. when selecting a greeting card and subsequently selecting an image from a database of images and then a text message from a database of text messages, the system automatically selects the layout from a greeting card template configured to accommodate the selected graphic and text. However, "the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143.01 (citing In re Ratti, 123 USPQ 349 (CCPA 1959)); see also MPEP §2143.01 (citing In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984)) ("If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Here, since the combining of either Sieber or Jecha with one another would materially alter the teachings and function of the other reference, they are not properly combined.

The present invention, as recited in independent claims 13 and 20, is directed to a system wherein the end user selects the layout and then selects the graphics and text to be inserted into the pre-defined template/layout. The template/layout is unalterable and instead of automatically selecting the layout based upon the text and graphic parameters set by the user, the present invention modifies the graphics or text to fit within the user-selected pre-defined and pre-prepared layout. This is simply not discussed in either Jecha or Sieber. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

CONCLUSION

From the foregoing amendments and remarks, Applicant believes that the currently amended claims are not rendered obvious by the cited references. Accordingly, Applicant believes that the present application is in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Scott W. Kelley", is written over the printed name and registration number.

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